## REMARKS

In response to the Office Action of August 23, 2005, Applicants have carefully considered the rejections of the Examiner in the above-identified application. In light of this consideration, Applicants believe that the claims remain allowable. Applicants respectfully request reconsideration of the rejection of the claims now pending in the application.

In this first Office Action of August 23, 2005, claims 1-23, are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,930,553 to Hirst et al. (hereinafter Hirst). Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over US 6,735,399 in view of Hirst.

Hirst relates to a consumable having a memory device for storing information such as usage information to be used by a the original manufacturer or re-manufacturer. The memory device can also be used to provided software updates or patches for the microcomputers within an image forming or other office automation device. Hirst also relates to the updating of the microcomputers within an image forming device via a communication channel when flagged by the memory in the consumable.

Since no line or column citation is made, it is not clear upon what section of Hirst to which the Examiner is relying when he states on page 5 of the 1st office action that Hirst provides "it is disclosed that an update to color lookup tables may be necessary as toner formulations are optimized because it is sometimes necessary to alter some or all of the electrographic printing parameters to take advantage of the new toner formulation." The Applicants are unable to find such language or disclosure in Hirst. Indication from the Examiner by citation to Hirst of where this language or teaching may be found, would be most welcome.

In the interests of expediting the prosecution here, the Applicants have focused on column 5 lines 7-24 of Hirst, and in particular lines 19-23 where Hirst does provide "Memory segment provides storage space for..... new lookup tables such as the color lookup tables."

The Applicants wish to particularly point out the claim language of their claim 1 which provides "the memory having stored within a look up table of coefficient values relating to the utilization of the replaceable sub-assembly ***responsive to a design variance in the customer replaceable unit***;". Hirst does not so teach.

Thus, Hirst never addresses the Applicant's expressed problem that subsequent to a machine's manufacture and release, that it may be desirable for a CRU design to vary over the course of time due to manufacturing changes or to solve post launch problems with either the CRU or a CRU and machine interaction. (See page 2, paragraph 3, of the application specification). Such a design change may require the CRU to be operated by the machine in a changed manner.

A §102 "anticipation" rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claim. That is, §102 anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. That is the unequivocal current and controlling view of the Federal Circuit. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); Atlas Powder v. E. I. DuPont, 750 F. 2d 1569, 224 U.S.P.Q. 409 (Fed. Cir. 1984); Jamesbury Corp. v. Litton Industrial Products, 756 F.2d 1556, 225 U.S.P.Q. 253 (Fed. Cir. 1985); Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 138, 231 U.S.P.Q. 644, 646 (Fed. Cir. 1986); and Davis v. Loesch, 27 U.S.P.Q. 2d 1440, 1445 (Fed. Cir. 1993), citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920

(Fed. Cir.), cert. denied, 493 U.S. 853 (1989), "The identical invention must be shown in as complete detail as contained in the ... claim."

Hirst fails to teach the Applicant's invention. While Hirst may indeed employ some of the same elements, most essentially Hirst does not teach the same limitations or utilization of those elements and limitations as is claimed by the Applicant. Hirst never contemplates that it may be desirable for a CRU design to vary over the course of time due to manufacturing changes or to solve post launch problems with either the CRU or a CRU and machine interaction. As a consequence, Hirst never teaches providing a replaceable sub-assembly having stored within an upgrade of coefficient values relating to the utilization of the replaceable sub-assembly in a machine responsive to a design variance in the customer replaceable unit. Thus, Hirst never provides the advancement of the art provided by the Applicant. The Court of Appeals for the Federal Circuit has stated, although the differences between the claimed invention and the prior art may seem slight, those differences may also have been the key to the advancement of the art. Reference, for example, Jones v. Hardy, 220 U.S.P.Q. 1021 (Fed. Cir. 1984).

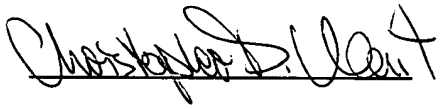
Thus, as the Hirst reference relied upon in the office action for a §102(b) rejection does not contain every element and limitation recited in the claims, in as complete detail as is contained in the claims, and arranged as recited in the claims, that rejection must be respectfully traversed as improper.

As to the rejection of claims 1-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over US 6,735,399 in view of Hirst, please find herein an executed Terminal Disclaimer to obviate the double patenting rejection.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,



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